

Remarks/Arguments

Claims 1 to 3 are pending. Claims 1 to 3 have been amended to place them more in U.S. form and practice.

The Office Action stated: that the listing of references in the specification is not a proper information disclosure statement; that 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper."; and that, therefore, unless the references have been cited by the Examiner on form PTO-892, they have not been considered. Applicants disagree with this statement. The Examiner is required to read and consider all of the disclosure in the application, including the prior art disclosed and discussed in the application.

Under the heading Background Art, a detailed description of certain prior art is set out on page1, lines 8 and 9, and page 1, line 12, to page 2, line 18, of the application – it disclosure that the Examiner has to read and consider like all of the rest of the disclosure in the application.

The Office Action stated that the following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in the Office Action:

(a) A patent may not be obtained through the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been

obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 3 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0130139 (Shiraishi et al.) in view of U.S. Patent No. 5,497,910 (Meadows et al.). Applicant traverses this rejection.

A very important feature of the claimed invention of this application is the relationship between the expanding memory of the inner layer and the filtration resistance of the filter. The combination of the two rejection references does not result in applicants' claimed invention. Shiraishi et al. does not disclose that its inner layer has expanding memory. Meadows et al. does not disclose use of a filter. All of the disclosure of the rejection references (and other prior art of record) has to be considered under Section 103(a). Since Meadows et al. does not use a filter, the combination of Shiraishi et al. and Meadows et al. would not use a filter. [The Examiner has no basis of fact and/or law in the record to assert that the lack of a filter in Meadows et al. would have to give way to the use of a filter by Shiraishi et al. – to contend otherwise is mere hindsight and speculate by the Examiner. The Examiner has no basis (in the record) under Section 103(a) to choose one combination over the other. Section 103(a) requires facts, not speculation and hindsight.]

The Office Action stated that the following is in reference to Claim 1:

The Office Action stated that Shiraishi et al. teaches:

A discharging container with a filter (1) comprising:

a bottle (2) which is formed in a manner wherein an inner layer (22) peelable from an outer layer (21) is formed on an inner surface of the outer layer;

a plug body (3) placed on a mouth portion (2a) of the bottle; and

a filter provided (7) in a discharging pass (10) which is provided in the plug body for discharging liquid kept in a body of the inner layer provided.

The Office Action further states that Shiraishi et al. further teaches:

wherein a dispensing valve (8) has a memory which expands the valve in a manner wherein a difference between an inner negative pressure and an ambient air is higher than a filtration resistance of the filter (see page 6, [0075] last 7 lines); and

wherein the negative pressure is caused by the memory of the valve (8) and by that liquid remained in a second side of the filter is sucked into a primary side of the filter (see [0043] and [0053]).

Shiraishi et al. does not teach or suggested applicants' claimed invention.

The Office Action stated that Shiraishi et al. differs from the claim in that it is the resilient dispensing valve (8) and its associated connector sleeve (83) which causes the remaining liquid to be sucked into a primary side of the filter rather than the memory of inner layer (22) which is disclosed to be made of a synthetic resin made of a resilient material (see [0057] and [0060]). This statement is incorrect and incomplete. Nowhere apparently does Shiraishi et al.

disclose or suggest the (claimed) expanding memory feature of the inner layer.

Shiraishi et al. does not teach or suggest applicants' claimed invention.

Meadows does not cure the defects of Shiraishi et al. in the quest for applicants' claimed invention.

The Office Action states that Meadows et al. teaches:

In Figs. 1-3 of a dispenser similar to that of applicants' and Shiraishi et al. to make an inner layer (inner bottle 30) from a resilient (compressible) material (LDPE) configured so as to create a "suck back" vacuum (see col. 4, lines 57 to 62, and col. 5, lines 35 to 43).

The Office Action stated that it would have been obvious to one having ordinary skill in the art at the time of the invention to have applied the teaching of using the characteristics of the compressible inner bottle to suck back liquid into the inner layer of Meadows et al. in the dispenser of Shiraishi et al. because doing so would allow the suck back function to be performed without the use of a resilient valve. Applicants traverse this statement. The Examiner has not factually resolved the level of ordinary skill in the art so the Examiner has no basis in the record for asserting/stating what would be obvious to one ordinarily skilled in the art.

The Office Action stated, further, the application of the teaching of Meadows et al. to Shiraishi et al. constitutes no more than combining prior art elements according to known methods to yield predictable results and the use of a known technique to improve similar device in the same way supporting a conclusion of obviousness in accordance with the guidance of *KSR International*

Co. v. Teleflex Inc. (KSR), 550 U.S.____, 82 USPQ2d 1385. Applicants traverse this statement. The Supreme Court in its KSR decision required that a three prong factual inquiry first be established in the record before any obviousness holding (rejection) could be made. One of the three mandatory factual inquiries that had to be made was the factual resolution in the record of the level of ordinary skill in the art – such mandatory resolution is missing in the case at bar. A holding of obviousness cannot be made until such foundation has been made in the record. Such mandatory foundation is missing from this case, hence the secondary considerations are not available. The Examiner has not even factually established in the record that “predictable results” are yielded by combining the two rejection references, or that the two rejection references are combinable in the manner attempted by the Examiner. It appears that this rejection is based on forbidden hindsight. The Examiner still has the burden of proof to prove in the record his various factual assertions.

It is clear that Claim 1 has not been proven to be obvious over the two rejection references, singularly or in combination.

The Office Action stated, in reference to Claim 2, see Shiraishi et al. [0067]. The independent claim is not obvious to one ordinarily skilled in the art so this dependent claim is also not obvious to such person.

The Office Action stated, in reference to Claim 3, see Shiraishi et al., Fig. 1.

Withdrawal of this rejection is requested.

The Office Action stated: that the prior art made of record and not relied upon is considered pertinent to applicants' disclosure; and that the remaining references listed on the attached PTO-892 have been included because they show hand held dispensing devices with inner and outer compressible containers. Such references do not make the claimed invention obvious.

The amended Abstract is submitted on the separate page in the Appendix.

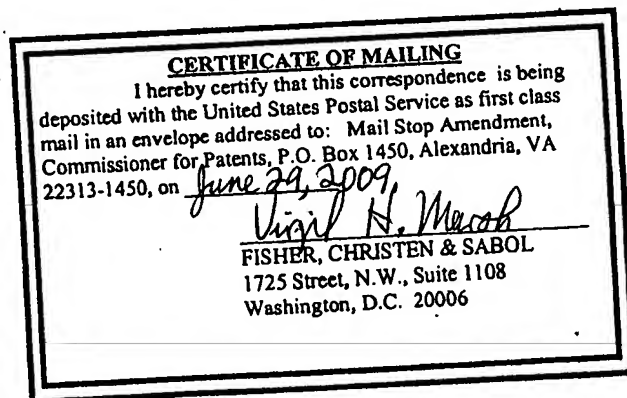
Reconsideration, reexamination and allowance of the claims re requested.

Date: June 29, 2009

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Appendix